

NOV 15 2006

003/021

Application Ser. No. 10/600,121

**REMARKS**

1. Applicant thanks the Examiner for the Examiner's comments which have greatly assisted Applicant in responding.

2. **35 U.S.C. §102(b).**

Claims 1, 2, 5-12, 16-18, 21-28, and 32-50 stand rejected under 35 U.S.C. §102(b) as being anticipated by Motoyama U.S. Patent No. 5,913,202 (herein "Motoyama").

Applicant respectfully traverses. Applicant incorporates prior responses herein, in particular, descriptions of the disclosures of cited references and descriptions of the claimed invention.

Claim 45

Claim 45 is shown below for convenience with emphasis added:

45. (previously presented) A process for establishing user authentication when the user is not present, comprising operations of:

**at a time when the user is engaged in a live authenticated session with an online service provider, the online service provider asking the user for permission for the online service provider to conduct at least one subject purchase at a later point in time when the user is no longer engaged in a live authenticated session with the online service provider;**

**responsive to an affirmative answer, the online service provider sending registration data to at least one of:  
a trusted discovery service;**

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an online wallet responsible for providing finance information  
to carry out the subject purchase;

**at a time when the user is not present, the online service  
provider initiating a purchase transaction on behalf of  
the user, and in response thereto, submitting a request  
to reveal finance information of the user to implement  
the purchase transaction, the request being submitted  
to the trusted discovery service;**

responsive to the request, the performing at least one of the  
following operations:

the trusted discovery service checking for presence of the  
registration to determine if the user gave prior  
permission for conducting the requested transaction  
with the online wallet when the user is not present,  
and if so, the trusted discovery service authorizing the  
online wallet to reveal the requested finance  
information of the user to complete the requested  
transaction;

in the event registration lies with the online wallet, the trusted  
discovery service forwarding the request to the online  
wallet for determination therein as to whether the user  
gave prior permission for conducting the requested  
transaction with the online wallet.

The Examiner asserts that the first limitation (reproduced in bold type  
hereinabove) is disclosed in Motoyama's col 10, line 24 through column 11, line  
42 and with no other comments.

First, Applicant asserts that the citation is too long and complex because it  
covers many paragraphs and many elements and the Examiner failed to clearly

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show which elements of Motoyama anticipate which part of the limitation of the claimed invention.

According to 37 CFR § 1.104 Nature of examination, (c) (2), reproduced hereinbelow, when a reference is complex, the particular part relied on must be designated as nearly as practicable. 37 CFR § 1.104 is show hereinbelow as follows:

*(c) Rejection of claims.*

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Therefore, in view of the above, Applicant respectfully asserts that the Examiner failed to comply with 37 CFR § 1.104 Nature of examination, (c) (2). On this alone, Applicant is of the opinion that the rejection is improper.

Applicant also looked to the **Response to Arguments** by the Examiner. The Examiner asserted that Motoyama discloses automatic bill payments. Further, the Examiner explained as follows:

"A client sets up an agreement with a bank. Once the client has an agreement with the bank, the bank pays bills online on behalf of the client. All payments made by the bank, on behalf of the client, are made without a live authenticated session with the client. The bank will release the necessary funds to pay the client's bills without having a live authenticated session with the client."

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Applicant respectfully points out that the above are the views and conclusions of the Examiner which are not permitted and the Examiner did not take Official Notice. Motoyama did not disclose any of the above details other than the phrase automatic bill payment function. So, what is left is for the Examiner to assert that the first limitation reads on the disclosed automatic bill payment. The MPEP is quite clear how to reject a claim under 35 USC 102(b), as follows (emphasis added):

2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e) [R-1]

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not

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required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

Applicant has shown that the Examiner failed to comply with this guideline because the identical invention was not shown in as complete detail as contained in the claim and the elements were not arranged as required by the claim, at least because not all elements in that particular limitation were disclosed in the Motoyama reference.

Therefore, on this basis alone, the rejection of Claim 45 under 35 USC 102(b) is deemed to be improper.

Also, regarding the limitation, a trusted discovery service, the Examiner relied on Col. 3, line 61 to Col. 4, line 9 for disclosing an element is the equivalent to the claimed trusted discovery service. Again, the Examiner failed to designate the particular part relied on as nearly as practicable. It is possible that the Examiner meant Motoyama's item 15 in Fig. 1, which is, according to the recitation, client information storage means.

Then, proceeding further with the Examiner's rejection, the Examiner rejected the limitation, at a time when the user is not present, the online service provider initiating a purchase transaction on behalf of the user, and in response thereto, submitting a request to reveal finance information of the user to implement the purchase transaction, the request being submitted to the trusted discovery service, by relying on the same part of the Motoyama reference as for the first limitation. But, nowhere does this same section, which describes a single transaction with the user present the entire transaction as pointed out in a prior response, disclose at least at a time when the user is not present. Nowhere does this same section disclose the request being submitted to the trusted discovery service.

Going further, the same section of Motoyama was relied on to reject the claimed limitation, responsive to the request, the performing at least one of the following operations: the trusted discovery service checking for presence of the registration to determine if the user gave prior permission for conducting the requested transaction with the online wallet when the user is not present, and if so, the trusted discovery service authorizing the online wallet to reveal the requested finance information of the user to complete the requested transaction. The Examiner's assertion that the above limitation is disclosed in that section to Motoyama is a mistaken assertion, *at least* because nowhere is the trusted discovery service, which the Examiner asserted was item 15, disclosed in that section to Motoyama. The Examiner is clearly applying a piece meal rejection which is not allowed.

MPEP 707.07(g) Piecemeal Examination states: Piecemeal examination should be avoided as much as possible. However, Applicant has shown that the Examiner rejected Claim 45 by piecemeal examination because he simply tried to find elements which merely met the terms of the claim, and not the heart of the claimed invention (as described to be different from Motoyama's disclosure in a previous response.)

Finally, Applicant respectfully reminds the Examiner that Applicant is afforded a presumption of validity and the burden is on the Examiner to show otherwise.

In view of the above, Applicant has shown that the Motoyama reference does not teach every element of the claim. Accordingly, Claim 45 and the respective dependent claims are deemed to be in allowable condition because, simply put, the claims are allowable because they meet the conditions for allowance set forth by the applicable Patent Laws, Patent Office Rules, and controlling Case Law.

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Based on the same rationale, in view of the argument hereinabove, Claims 1, 17, 33, and 39, and the respective dependent claims, are deemed to be in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §102(b).

3. 35 U.S.C. §103(a).

(a) Claims 3, 4, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motoyama as applied to Claims 1 and 17 hereinabove, and further in view of Van Oorschot *et al* ("Oorschot") U.S. Patent No. 5,699,431.

The rejection of Claims 3, 4, 19, and 20 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 45, above. Claims 3, 4, 19, and 20 are dependent upon Independent Claims which are deemed to be in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(b) Claims 13, 14, 29, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motoyama as applied to Claims 1 and 17 hereinabove, and further in view of Ramasubramani *et al* ("Ramasubramani") U.S. Patent No. 6,516,316 B1.

The rejection of Claims 13, 14, 29, and 30 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 45, above. Claims 13, 14, 29, and 3 are dependent upon independent Claims which are deemed to be in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(c) Claims 15 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motoyama as applied to Claims 1 and 17 hereinabove, and further in view of Yu U.S. Patent No. 4,919,545.

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The rejection of Claims 15 and 31 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 45, above. Claims 15 and 31 are dependent upon independent Claims which are deemed to be in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).



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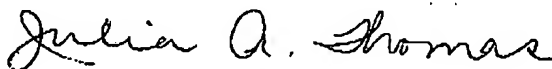
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**CONCLUSION**

Based on the foregoing, Applicant considers the present invention to be distinguished from the art of record. Accordingly, Applicant earnestly solicits the Examiner's withdrawal of the objections and rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States patent. The Examiner is invited to call to discuss the response.

Respectfully Submitted,



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